

Notice of Allowability

Application No.

09/826,789

Examiner

Janis L. Dote

Applicant(s)

SUZUKI ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Jun. 9, 2006.
2. ☒ The allowed claim(s) is/are 8,21,30 and 39.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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1. The examiner acknowledges the cancellation of claims 1-6, 9-20, 22, 32-38, and 40 set forth in the amendment filed on Jun. 9, 2006, which has been entered. Claims 8, 21, 30, and 39 are pending.

REASONS FOR ALLOWANCE

2. The following is an examiner's statement of reasons for allowance:

The objection to the specification under 35 U.S.C. 132, set forth in the office action mailed on Oct. 13, 2005, paragraph 4, has been mooted by the deletion of the paragraph inserted in the specification at page 56, between lines 5 and 6, in the amendment filed on Sep. 26, 2003, set forth in the amendment filed on Jun. 9, 2006.

The rejection of claims 1-6, 9, 20, and 38 under 35 U.S.C. 112, first paragraph, set forth in the office action mailed on Oct. 13, 2005, paragraph 6, has been mooted by the cancellation of those claims set forth in the amendment filed on Jun. 9, 2006.

The rejections under 35 U.S.C. 103(a) of claims 1-6, 9-20, 22, 32-38, and 40 over US 5,733,699 (Asanae'699) combined with European Patent 0936507 A2 (EP'507) and the other cited prior art, set forth in the office action mailed on Oct. 13, 2005,

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paragraphs 9-16, have been mooted by the cancellation of those claims set forth in the amendment filed on Jun. 9, 2006.

Claims 8, 21, 30, and 39 are allowable over the prior art of record.

None of the prior art of record, in particular US 5,733,699 (Asanae'699) and European Patent 0936507 A2 (EP'507), teaches or suggests a toner comprising a binder resin comprising a polyester resin and a magnetic material as recited in the instant claims, where the binder resin has a molecular weight distribution as recited in the instant claims, and the toner contains a THF-insoluble (tetrahydrofuran-insoluble) component in an amount of 2 wt% to 40 wt% of said toner.

US 6,335,137 B1 (Suzuki) and FR 2,785,190 (FR'190), which is the French equivalent of Suzuki, both teach a toner comprising a binder resin comprising a polyester resin and THF soluble components having a molecular weight distribution as recited in the instant claims. See Suzuki, col. 3, lines 50-55, which discloses that the THF soluble components have at least one peak in the molecular weight range of 1,000 to 10,000 and that peak has a half width of not greater than 15,000. Also see the European Patent Abstract Database (EPAB) abstract of FR'190; and FR'190, page 4, lines 24-34. However, Suzuki and FR'190 both teach that the toner comprises preferably from 5 to 40% by

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weight of chloroform insoluble components, not the THF insoluble components recited in the instant claims. Suzuki, col. 3, lines 1-6, and col. 4, lines 29-36; EPAB abstract; and FR'190, page 4, line 35, to page 5, line 2, and page 7, lines 12-19. There is not enough evidence on the present record for a person having ordinary skill in the art to reasonably presume that either the Suzuki toner or the FR'190 toner further comprises from 2 to 40 wt% of tetrahydrofuran insoluble components based on the weight of the toner as recited in the instant claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L. Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (571) 273-8300.

Any inquiry of papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD

Jun. 16, 2006

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
GROUP ~~1530~~
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